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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/397,034 09/16/99 ATAKE

H DAIN: 435A

EXAMINER

IM22/0504

PARKHURST & WENDELL LLP
1421 PRINCE STREET SUITE 210
ALEXANDRIA VA 22314-2805

JACKSON, M

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

05/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/397,034

Applicant(s)

ATAKE, HIROYUKI

Examiner

Monique R Jackson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☒ received in Application No. (Series Code / Serial Number) 08/957,068.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

On Page 16, Lines 24-29 – it is stated that “any conspicuous scratches were not found on the test samples ... B’... and conspicuous scratches were found on ... B’.” It is not clear how the B’ sample can be listed in both areas.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title as amended on 9/16/99 is “Sheet Decorating Molding Method”, however the invention is not directed to a method, it is directed to a decorative sheet. Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 7-8 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-8 of the parent case 08/957, 068, and now prior U.S. Patent No. 6,001,292. This is a double patenting rejection.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al. Takada et al. teach a molding coated with a decorative sheet comprising an acrylic resin layer with a glass transition temperature greater than or equal to 80°C, and a backing resin sheet between the molding and the acrylic sheet (Figures 2A-2C, Figure 6, and Claim 1.) The acrylic resin may comprise lubricants and other additives as desired. Takada et al. do not teach a coefficient of kinetic friction of the acrylic layer with respect to glass of 0.2 to 0.9, however this is a measured value ranging from 0.0 to 1.0 and is a function of the two surfaces tested and any lubricants used. The addition of a lubricant to the acrylic layer modifies the material and reduces the coefficient of kinetic friction. It is well known in the molding art to include lubricants to provide anti-slip characteristics to a film or sheet.

7. The Examiner notes that on pages 15-16 of the specification, the Applicant includes a table containing sample data and a discussion of the results from the four samples tested. It is further noted that of these four samples tested, only two, 0.45 and 0.6, fall within the claimed range of 0.2 to 0.9, and only one of these two samples has a glass transition temperature less than 80°C. In fact, the Applicant admits on page 16, lines 29-31, that only Sample A' met the requirements. Therefore, the data presented is inconclusive and in the absence of unexpected

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results, it would have been obvious to one skilled in the art at the time of the invention to modify the amount of lubricant as needed in the invention as taught by Takada et al.

Conclusion

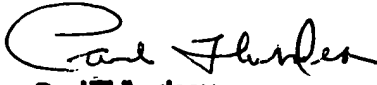
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tatebayashi teaches a molding coated with a decorative sheet comprising an acrylic layer and a backing resin sheet interposed between the molding and the decorative sheet. Ikemoto et al. teach a decorative material coated with an acrylic resin and a backing resin sheet interposed between the acrylic resin and the base material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-6078 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

mrj
April 27, 2000


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700